



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,640	12/20/1999	LAURA ANNE MAHAN	81395-146	1424

26123 7590 06/02/2005

BORDEN LADNER GERVAIS LLP
WORLD EXCHANGE PLAZA
100 QUEEN STREET SUITE 1100
OTTAWA, ON K1P 1J9
CANADA

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
----------	--------------

2161

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,640

Applicant(s)

MAHAN ET AL.

Examiner

Marc R. Filipczyk

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-16 and 20-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16 and 20-44 is/are rejected.
- 7) ☒ Claim(s) 1-6,20-28,31-41,43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

PD

Response to Amendment

This action is responsive to Applicant's RCE request and amendment submitted on April 21, 2005.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 21, 2005 has been entered.

Amended claims 1, 3-6, 8-11, 13-16 and 20-40 are pending.

Oath/Declaration

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over Inventor No. 3 (K. Forbes) signature providing a complete post office address is required. Appropriate correction is required.

Claim Objections

Art Unit: 2161

Claims 1 and 20 are objected to because of the following informalities. The term “method” should be replaced with “computer implemented method” to clarify that the method steps are performed by a computer.

Claims 31 and 32 are objected to because the term “apparatus” should be replaced with “computer apparatus” to clarify that the apparatus steps are performed by a computer.

Claims 3-6, 41, 21-28 and 43 depend from claims 1 and 20 respectively, thus contain the same informalities as claims 1 and 20 and are objected to on the same basis.

Claims 33-40 and 44 depend from claim 32, thus contain the same informalities as independent claim 32 and are objected to on the same basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8, 9, 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention is within the technological arts.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences,

Art Unit: 2161

for example) and therefore are found to be non-statutory subject matter. For a system claim to pass muster, the recited steps must somehow apply, involve, use, or advance the technological arts.

In the present case, independent claims 8 and 29 are not tangible. The processor circuit is non-statutory because a signal can be embodied in a carrier wave received from the internet, thus is not tangible.

Independent claims 9 and 30 are not tangible. The computer data is non-statutory because a signal can be embodied in a carrier wave received from the internet, thus in not tangible.

These claims 8, 9, 29 and 30 only constitute an idea of associating an electronic calendar with regard to a search result comprise descriptive material that is not tangible embodied on a computer readable medium.

Since the claimed invention, as a whole, is not within the technological arts as explained above, claims 8, 9, 29 and 30 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-6, 8-11, 13-16 and 20-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 8-11, 20, 29-32, the feature of “modifying said file of said electronic calendar with regard to said search result” is indefinite. It is not clear what modification takes place based on a search result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8-11, 13-16, 20-22 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vora et al. (U.S. Patent No. 5,623,652) in view of Cahill Jr. (U.S. Patent No. 5,428,784).

Regarding claims 1, 8-11, 20 and 29-32, Vora discloses an apparatus and method for associating information with an object in a file (fig. 2, block 201, Vora), the apparatus comprising a scheduler (fig. 7B, items 727 and 729, Vora) including a component for associating a search key (fig. 2, items 201 and 203, and fig. 7B, keys 726 and 733 with 735, Vora) with the object in the file by tagging the object (fig. 2, items 205 and 207, and fig. 6, box 615 and col. 15, lines 20-27, Vora), wherein said scheduler is operable to schedule a search for local and external information (col. 9, line 56 to Col. 10, line 2, Vora) using said search key for automatic execution at a pre-scheduled time (fig. 2, items 201 and 203, Vora) by a search interface operable to initiate a pre-scheduled search (fig. 7B, Vora), associating a search result with the tag

Art Unit: 2161

(fig. 6, 617, Vora), and modifying the file with regard to said search result (fig. 6, item 619, Vora), but Vora does not teach a file of an electronic calendar.

(Note: elements 726, 733 and 735 and index are used by the search key: elements 201 and 203)

However, Cahill teaches an apparatus and method for linking internet data (information sources) with a file of an electronic calendar (title and abstract, Cahill). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made having Vora's local and external information sources to modify the local information to comprise a file of an electronic calendar information as in Cahill system. One would have been motivated to use a calendar file in Vora because Vora is concerned with improving searching for information in a local and internet network (col. 9, line 56 to Col. 10, line 2, Vora).

Regarding claims 3, 4, 13 and 14, Vora/Cahill disclose tagging and labeling objects (fig. 2, items 205 and 207, and fig. 6, box 615 and col. 15, lines 20-27, Vora).

Regarding claims 5, 6, 15, 16, 21 and 33, Vora/Cahill disclose scheduling comprises storing (fig. 1, items 11 and 39, Vora) a search key in association with a time of execution at which said search is to be executed (fig. 7B, items 726, 733, 727, 729 and 735, Vora) and identifying said object (figures 2 and 4A, Vora).

Regarding claims 22 and 34, Vora/Cahill disclose the search comprising a search engine (fig. 2, box 207, Vora).

Claims 23-28 and 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vora et al. (U.S. Patent No. 5,623,652) in view of Cahill Jr. (U.S. Patent No. 5,428,784) further in view of Stark (U.S. Patent No. 5,935,210).

Regarding claims 23 and 35 Vora/Cahill disclose all of the claimed subject matter as discussed above with respect to claims 20 and 32, including an internet server and a gateway (fig. 1, blocks 63 and 61, Vora), but do not expressly teach a search associated with a universal resource locator (URL). However, Stark discloses a mapping structure of a collection of computer resources (title and fig. 4, Stark) where an URL is associated with a search object (fig. 5, items 120, 122, 124 and 126, Vora). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Vora/Cahill system in view of Stark because Vora/Cahill use an internet server to access local and external sources which could be implemented in view of Stark to associate an URL with an object. One of ordinary skill in the art would have been motivated to map URL with objects to link the desired reference of a search.

Regarding claims 24, 28, 36 and 40, Vora/Cahill in view of Stark disclose running scripts to populate fields of a search engine (fig. 6A, items 202-214, Stark).

Regarding claims 25-27, 37-39 and 41-44 Vora/Cahill in view of Stark disclose URL and hyperlinks (fig. 5, items 142, 144, 150, 152, 154 and 156, Stark).

Response to Arguments

Applicant's arguments filed on April 21, 2005 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on pages 11 of the 4/21/05 response that Vora fails to mention or suggest to modify an electronic calendar's files with regard to the search results, or to pre-schedule any updating of an electronic calendar's files.

Examiner disagrees. Vora alone teaches all the features argued above including files except as stated in the rejection the files of Vora do not include an electronic calendar. However, Vora/Cahill teach updating electronic calendar's files (see fig. 6, item 619, Vora and abstract Cahill). For more information please see rejection above.

Second, in response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pre-schedule updating of an electronic calendar file) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues on pages 11 and 12 of the 4/21/05 response the logic to combine Vora in view of Cahill, and that Cahill does not teach involving any search results related to any calendar object.

Art Unit: 2161

Examiner disagrees. Vora system discloses searching local and external information sources (col. 9, line 56 to col. 10, line 2, Vora) and Cahill discloses linking electronic calendar “local source” with an electronic mail “external source” to find/search scheduled events on the electronic calendar overlapping with a time of receipt of the message sent (col. 4, lines 10-15, Cahill). Both systems are concerned with searching both local and external information sources to improve searching capabilities, and Vora/Cahill hence teach associating search information with a file of an electronic calendar (see rejection above).

Applicant argues on page 12 of the 4/21/05 response that Vora/Cahill in view of Stark do not overcome the deficiencies of Vora/Cahill.

Examiner disagrees. Vora/Cahill do not contain any deficiencies as explained above. No other issues regarding Stark have been raised.

With respect to all the pending claims 1, 3-6, 8-11, 13-16 and 20-40, Examiner respectfully traverses Applicant’s assertion based on the discussion cited and rejection cited above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2161

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
May 24, 2005


FRANTZ COBY
PRIMARY EXAMINER